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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,463	04/20/2004	Kraig A. Kirschner	7234-118/10405046	6433
167	7590	01/13/2006	EXAMINER	
FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			KING, ANITA M	
		ART UNIT	PAPER NUMBER	
		3632		
DATE MAILED: 01/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/829,463	KIRSCHNER, KRAIG A.	
	Examiner	Art Unit	
	Anita M. King	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 October 2005 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

This is the second office action for application number 10/829,463, Sway Brace Clamp, filed on April 20, 2004.

Drawings

The drawings were received on October 13, 2005. These drawings are approved.

Claim Rejections - 35 USC § 112

Claims 1 and 3-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claims 1, 5, and 11 clearly indicates that a subcombination is being claimed, e.g., "a sway brace clamp being for clamping pipe of specified outside diameter having a nominal outside radius and a negative radial mill tolerance..." and "a sway brace assembly for supporting pipe of specified outside diameter having a nominal outside radius and a negative radial mill tolerance...", respectively. This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "a sway brace clamp" and "a sway brace assembly," the pipe and the characteristics thereof being only functionally recited. This presents no problem as long as the body of the claim also refers to the pipe functionally.

The problem arises when the pipe is positively recited within the body of the claim, such as, "each of the arcuate sections stressed and deformed about the specified outside diameter, a maximum distance perpendicular to the attachment plane between the attachment plane and the concave side of the arcuate section for each elongate bar is .005" less than the nominal outside radius minus the negative radial mill tolerance when the bar is unstressed," in claim 1; and "the arcuate section for each elongate bar being less than the nominal outside radius minus the negative radial mill tolerance," in claim 5. There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a sway brace clamp/assembly and a pipe are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the sway brace clamp/assembly or the sway brace clamp/assembly in combination with the pipe.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the sway brace clamp/assembly alone or the combination of the sway brace clamp/assembly and the pipe. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-6, 8-10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,998,691 to Brown. Brown discloses a clamp being for clamping pipe (9) of specified outside diameter with mill tolerance, comprising: two elongate bars, each elongate bar including an arcuate section (20a & 21a), a first straight section on one end of the arcuate section and a second straight section on the other end of the arcuate section, the first and second straight sections defining attachment surfaces on one side lying in a common attachment plate, each straight section having a through hole (7); fasteners (12d) extendable through the through holes to retain the two elongate bars together with the attachment surfaces of the first straight sections against the attachment surfaces of the second straight sections, respectively, each of the arcuate sections of the two elongate bars defining a center of curvature which lies substantially in the common attachment plane of the respective bar when clamped about the pipe with the attachment surface of the first straight sections against the attachment surfaces of the second straight sections, respectively; the fasteners each being a bolt with a nut (25) threadable thereon; short radiused sections attaching the ends of the arcuate sections to the straight sections; the maximum distance perpendicular to the attachment plate between the attachment plane and the concave side of the arcuate section for each elongate bar being less than the nominal outside radius minus the negative mill tolerance of the pipe of specified outside diameter when

the bar is unstressed to provide a designed clamping force imposed on the pipe of specified outside diameter with the attachment surface of the two bars positioned against one another about the pipe, respectively; and each of the arcuate sections of the two elongate bars defining a center of curvature which lies substantially in the common attachment plane of the respective bar when clamped about the pipe with the attachment surfaces of the first straight sections against the attachment surfaces of the second straight sections, respectively.

Brown further teaches that the maximum distance is a predetermined amount less than the nominal outside radius minus the negative radial mill tolerance of the pipe of specified outside diameter. Brown discloses the claimed invention except for the amount being .005". It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the maximum distance .005" less than the nominal outside radius minus the negative radial mill tolerance for the purpose of providing a specified distance to accommodate a pipe having a specified outside diameter and such a modification would not have produced any unexpected results since no criticality is provided for the distance.

Claims 1, 4-6, 8, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,131,859 to Giuliano. Giuliano discloses a clamp (10) being for clamping pipe (11) of specified outside diameter with mill tolerance, comprising: two elongate bars, each elongate bar including an arcuate section (15), a first straight section (16) on one end of the arcuate section and a second straight section (16) on the other end of the arcuate section, the first and second straight

sections defining attachment surfaces on one side lying in a common attachment plate, each straight section having a through hole (25a and 26); fasteners (27) extendable through the through holes to retain the two elongate bars together with the attachment surfaces of the first straight sections against the attachment surfaces of the second straight sections, respectively, each of the arcuate sections of the two elongate bars defining a center of curvature which lies substantially in the common attachment plane of the respective bar when clamped about the pipe with the attachment surface of the first straight sections against the attachment surfaces of the second straight sections, respectively; short radiused sections attaching the ends of the arcuate sections to the straight sections; the maximum distance perpendicular to the attachment plane between the attachment plate and the concave side of the arcuate section for each elongate bar being less than the nominal outside radius minus the negative radial mill tolerance of the pipe of specified outside diameter when the bar is unstressed to provide a designed clamping force imposed on the pipe of specified outside diameter with the attachment surfaces of the two bars positioned against one another about the pipe, respectively; and each of the arcuate sections of the two elongate bars defining a center of curvature which lies substantially in the common attachment plane of the respective bar when clamped about the pipe with the attachment surfaces of the first straight sections against the attachment surfaces of the second straight sections, respectively.

Giuliano further teaches that the maximum distance is a predetermined amount less than the nominal outside radius minus the negative radial mill tolerance of the pipe of specified outside diameter. Giuliano discloses the claimed invention except for the

amount being .005". It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the maximum distance .005" less than the nominal outside radius minus the negative radial mill tolerance for the purpose of providing a specified distance to accommodate a pipe having a specified outside diameter and such a modification would not have produced any unexpected results since no criticality is provided for the distance.

Claims 11, 12, 14-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,099,191 to Werner in view of Brown. Werner discloses an assembly (10) for supporting pipe of specified outside diameter with mill tolerance, comprising: a rigid link (24) including two attachments (12 and 36) displaced from one another; two elongate bars (38 & 40), each elongate bar including an arcuate section having two ends, first and second straight sections (42) having a through hole (44); fasteners extendable through the through holes to retain the two elongate bars together with the attachment surfaces of the first straight sections against the attachment surfaces of the second straight sections, respectively; the maximum distance perpendicular to the attachment plane between the attachment plane and the concave side of the arcuate section for each bar; the fasteners extending through the through holes of the straight sections and the second straight sections; each arcuate sections of the two elongate bars defining a center of curvature which lies substantially in the common attachment plane of the respective bar when clamped about the pipe with attachment surfaces of the first straight sections against the attachment surfaces of the

second straight sections, respectively; and the fasteners each being a bolt (46) with a nut (48) threadable thereon.

Werner discloses the claimed invention except for the limitations of the maximum distance being less than the nominal outside radius minus one-half the mill tolerance of the pipe of specified outside diameter when the bar is unstressed to provide a designed clamping force imposed on the pipe with the attachment surfaces to the two bars positioned against one another about the pipe, the maximum distance being .005" less than the nominal outside radius minus the negative radial mill tolerance, and short radiused sections attaching the ends of the arcuate sections of the straight sections.

Brown teaches that it is known to have a clamp including short radiused sections attaching the ends of the arcuate sections to the straight sections and the maximum distance being a predetermined amount less than the nominal outside radius minus the negative radial mill tolerance of the pipe and wherein the straight sections attaching against one another. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the clamp in Werner to have included the clamp as taught by Brown for the purpose of resisting upward or downward loads.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the maximum distance .005" less than the nominal outside radius minus the negative radial mill tolerance for the purpose of providing a specified distance to accommodate a pipe having a specified outside diameter and such

a modification would not have produced any unexpected results since no criticality is provided for the distance.

Allowable Subject Matter

Claims 7 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed October 13, 2005 have been fully considered but they are not persuasive.

In response to applicant's arguments in regards to the 112 2nd paragraph rejection, the applicant didn't specify if the invention was drawn to the subcombination of a sway brace clamp/assembly or the combination of the sway brace clamp/assembly and the pipe, and thus, the rejections above are based on the subcombination.

In response to applicant's argument that neither Brown or Giuliano teach a clamping force on the pipe, it is evident that a clamping force is disposed on the pipe by the clamps in Brown and Giuliano if the pipe is prevented from moving up or down in a hanging position. The material of the pipe is irrelevant since it is not clear for the claimed subject matter if the pipe is a positive element of the claimed invention. It is suggested that the applicant claims the combination of the sway brace clamp/assembly

in claims 1, 5, and 11 since it is apparent that the invention lies between the relation of the nominal outside radius and negative radial mill tolerance of the pipe and the sway brace clamp/assembly.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (571) 272-6817. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anita M. King
Primary Examiner
Art Unit 3632

January 9, 2006